

**REMARKS**

The Applicants respectfully request further examination and consideration in view of the above amendments and the arguments set forth fully below. Claims 1-16 were previously pending in this application. Within the Office Action, Claims 1 and 9-16 stand rejected. Claims 2-8 are allowed. By the above amendments, Claim 14 has been amended. No claims have been added, and no claims have been canceled. Accordingly, Claims 1-16 are currently pending. No new matter has been added by this amendment.

**Request for Consideration of Pending Information Disclosure Statements**

On March 23, 2005 and August 25, 2005, the Applicants filed two Supplemental IDS in this matter, which have not yet been considered. The Applicants respectfully request that the Examiner consider these two Supplemental IDS and indicate this on the appropriate PTO Form 1449.

**Rejections under 35 U.S.C. § 112**

The independent claim 14 stands rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Claim 14 is now amended, such that the limitations in the claim now contain correct antecedent basis.

**Rejections under 35 U.S.C. § 102(e)**

Claims 1, 9-13, 15 and 16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kobayashi, U.S. Patent No. 6,199,122 B1 (hereinafter, "Kobayashi"). Within the Office Action, it is stated that the parent case 09/034,173 of the instant application does not have support for the newly added limitation. The Applicants respectfully traverse these rejections.

1. Kobayashi cannot be considered prior art to the instant application

Kobayashi is directed to using an USB convenient form factor (USB) to connect a flash memory card to a host computer, as a mass memory device, using an ATA controller. The filing date of Kobayashi is July 22, 1998. The parent case 09/034,173 entitled "Improved Compact Flash Memory Card and Interface", Estakhri et al., now issued as Pat. No. 6,182,162, has a filing

date of March 2, 1998, nearly five months prior to the filing date of Kobayashi. Further, contrary to what is stated in the Office Action, the parent case 09/034,173 supports the limitations found in Claims 1, 9-13, 15, and 16, which will be discussed in greater detail later in this paper.

2. Claim 1

The independent Claim 1 stands rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi. Within the Office Action, it is stated that “Kobayashi teaches a flash memory card interface system (fig. 1) for detachably coupling to a host computer system (computer 11 of fig. 1), the flash memory card interfacing system also configured for performing data storage and control operations (col. 5 line 56 to col. 6 line 8), the flash memory card interfacing system comprising: a device (reader/writer 12 of fig. 1) for connecting a flash memory card (removable memory card 13 of figs 1 and 2) to a USB port (USB interface 121), such that the flash memory card operates as a removable data storage for the host computer system (col. 5 line 56 to col. 6 line 49).” The Office Action further claims that the newly added limitation “such that the flash memory card operates as a removable data storage for the host computer system” is not supported by the parent case 09/034,173 of the instant application. The Applicants respectfully traverse this rejection.

The independent claim 1 is directed to a flash memory card interfacing system for detachably coupling to a host computer system, the flash memory card interfacing system also configured for performing data storage and control operations, the flash memory card interfacing system comprising: a device for connecting a flash memory card to a USB port, *such that the flash memory card operates as a removable data storage for the host computer system* (emphasis added). It would be apparent to one skilled in the art at the time of the effective filing date of the parent case 09/034,173 (namely, March 2, 1998) that a flash memory card inherently can operate as a removable data storage for a host computer system. Further, contrary to what is stated in the Office Action, the newly added limitation “such that the flash memory card operates as a removable data storage for the host computer system” is supported by the parent case 09/034,173 (e.g., see page 1, lines 6-11, page 3, lines 1-20, page 4, lines 3-24, and page 6, lines 10-12 of the specification for 09/034,173; see also Claims, 1, 2, 6, 7 and 8; see also Fig. 3). Hence, the parent case 09/034,173 supports the newly added limitation of “such that the flash memory card operates as a removable data storage for the host computer system.” As such, the parent case 09/034,173 with its filing date of March 2, 1998 antedates the filing date of

Kobayashi (July 22, 1998). Pursuant to MPEP 2136.05, the rejection under 35 U.S.C. § 102(e) is overcome by the parent case 09/034,173 antedating the filing date of Kobayashi. The present patent application is a continuation-in-part of the parent case 09/034,173. Thus, Kobayashi cannot be considered prior art to the instant application. For at least these reasons, Claim 1 is allowable over Kobayashi.

3. Claims 9-13

The independent Claim 9 stands rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi. Claims 10-13 depend from Claim 9. Within the Office Action, it is stated that “[a]s to claim 9, Kobayashi teaches a flash memory card interface system (fig. 1) for detachably coupling to a host computer system (computer 11 of fig. 1), the flash memory card interfacing system also configured for performing data storage and control operations (col. 5 line 56 to col. 6 line 8), the flash memory card interfacing system comprising: a device (reader/writer 12 of fig. 1) for connecting a flash memory card (removable memory card 13 of figs 1 and 2) to a USB port (USB interface 121), such that the flash memory card automatically configures itself to cooperatively operate in a selected operating [mode] through the device (Abstract).” The Office Action further claims that the newly added limitation is not supported by the parent case 09/034,173 of the instant application. The Applicants respectfully traverse this rejection.

The independent claim 9 is directed to a flash memory card interfacing system for detachably coupling to a host computer system, the flash memory card interfacing system also configured for performing data storage and control operations, the flash memory card interfacing system comprising: a device for connecting a flash memory card to a USB port, *such that the flash memory card automatically configures itself to cooperatively operate in a selected operating mode through the device* (emphasis added). Contrary to what is stated in the Office Action, the limitation of “such that the flash memory card automatically configures itself to cooperatively operate in a selected operating mode through the device” of Claim 9 is supported by the parent case 09/034,173 (e.g., see page 3, lines 11-18, page 4, lines 3-9, and page 7, lines 8-14 of the specification for 09/034,173; see also Claims 1, 2, 6, and 8). The parent case 09/034,173 states, in part, that “[u]pon initialization with an interface device, this improved compact flash memory card automatically detects which operation mode is used by this interface device and configures the memory card to be compatible with the present operation mode.” (page 4, lines 6-9) Hence, the parent case 09/034,173 supports the newly added limitation of “such that

the flash memory card automatically configures itself to cooperatively operate in a selected operating mode through the device.” As such, the parent case 09/034,173 with its filing date of March 2, 1998 antedates the filing date of Kobayashi (July 22, 1998). Pursuant to MPEP 2136.05, the rejection under 35 U.S.C. § 102(e) is overcome by the parent case 09/034,173 antedating the filing date of Kobayashi. The present patent application is a continuation-in-part of the parent case 09/034,173. Thus, Kobayashi cannot be considered prior art to the instant application. For at least these reasons, Claim 9 is allowable over Kobayashi.

Notwithstanding the fact that the Kobayashi cannot be considered prior art to the present invention, Kobayashi does not teach all the limitations found in Claim 9. Specifically, Kobayashi does not teach, disclose, or suggest at least one limitation of Claim 9, namely, “such that the flash memory card automatically configures itself to cooperatively operate in a selected operating mode through the device.” The Office Action erroneously states that the Abstract of Kobayashi teaches this limitation. The Abstract of Kobayashi instead teaches that a conversion controller of a reader/writer receives a command based on the USB from a computer and converts it into a command of the ATA specification for an ATA controller. “The controller accesses the memory card based on the command of the ATA specification thus supplied. The conversion controller converts the formats of the data of the USB specification and the data of the ATA specification to each other.” (Abstract) Hence, in Kobayashi, the flash memory card depends on the conversion controller to access the flash memory card and then convert data formats appropriately. Therefore, in Kobayashi, the flash memory card **does not automatically configure itself** to cooperatively operate in a selected operating mode through the device; it must rely on a conversion controller 122 of a reader/writer 12. In contrast, the present invention teaches that the flash memory card automatically configures itself to function a selected operating mode, “without the end user sending configuration instructions to the flash memory card or manipulating computer hardware settings.” (page 7, lines 10-16)

For at least these reasons, Claim 9 is allowable over Kobayashi. Claims 10-13 are dependent on the independent Claim 9. Accordingly, Claims 10-13 are also allowable as being dependent on an allowable base claim.

4. Claims 14-16

Claims 15 and 16 stand rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi. Within the Office Action, it is stated that as to these claims, “Kobayashi teaches the

flash memory card interfacing system 9, further comprising a fifty/sixty eight pin connector end configured to couple to the device (ATA connector 125 of fig. 1).” The Applicants respectfully traverse this rejection.

Claims 15 and 16 depend from the independent claim 14. The independent claim 14 is directed to a flash memory card interfacing system for coupling a flash memory card to a USB bus, the flash memory card interfacing system comprising: (a) the flash memory card for executing a write operation, a read operation, and an erase operation and comprising: an interface device for coupling the flash memory card to a USB port; a flash controller coupled to the flash memory card and a USB connector, the flash controller controlling the USB connector and configuring the flash memory card to a universal serial bus mode of the interface device; and flash interface circuitry coupled to the flash controller, the flash interface circuitry identifying the universal serial bus mode of the interface device; and (b) the USB connector for connecting to the USB bus, sending and receiving signals, and coupling the interface device to the flash memory card. Contrary to what is stated in the Office Action, the limitations of Claim 14 are supported by the parent case 09/034,173 (e.g., see page 1, lines 20-26, page 7, lines 1-32, and page 8, lines 1-32 of the specification for 09/034,173; see also Claims, 1, 2, 4, 6, 7, 8 and 10; see also Fig. 3). Hence, the parent case 09/034,173 supports the limitations of Claim 14. As such, the parent case 09/034,173 with its filing date of March 2, 1998 antedates the filing date of Kobayashi (July 22, 1998). Pursuant to MPEP 2136.05, the rejection under 35 U.S.C. § 102(e) is overcome by the parent case 09/034,173 antedating the filing date of Kobayashi. The present patent application is a continuation-in-part of the parent case 09/034,173. Thus, Kobayashi cannot be considered prior art to the instant application. For at least these reasons, Claim 14 is allowable over Kobayashi.

Notwithstanding the fact that Kobayashi cannot be considered prior art to the instant application, Kobayashi does not teach all the limitations of the independent Claim 14. Kobayashi does not teach, disclose, or even suggest at least one limitation of Claim 14, namely, a flash controller coupled to the flash memory module and a USB connector, the flash controller controlling the USB connector and *configuring the flash memory card to a universal serial bus mode of the interface device* (emphasis added). In Kobayashi, “the conversion controller converts the formats of the data of the USB specification and the data of the ATA specification to each other” (Abstract). However, Kobayashi does not teach, suggest, or disclose a flash controller that configures the flash memory card to a USB mode of the interface device. In

contrast, the present invention discloses a flash controller that configures the flash memory card to a selected operating mode of the interface device. (page 8, lines 12-14) One operating mode is the USB mode (Fig. 2). For at least these reasons, Claim 14 is allowable over Kobayashi.

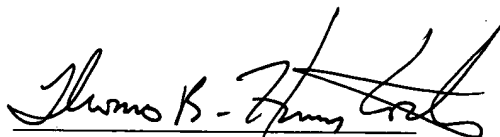
Claims 15 and 16 are dependent upon the independent Claim 14. As discussed above, the independent Claim 14 is allowable over the teachings of Kobayashi. Accordingly, Claims 15-16 are allowable as being dependent upon an allowable base claim, and are now in condition for allowance.

**Conclusion**

For the reasons given above, Applicant respectfully submits that Claims 1-16 are in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, they are encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,  
HAVERSTOCK & OWENS LLP

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**CERTIFICATE OF MAILING (37 CFR § 1.8(a))**

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HAVERSTOCK & OWENS LLP.  
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